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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,689	02/27/2004	Takehiro Okanaka	KASAP047	9344

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BEYER WEAVER & THOMAS LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER

NGUYEN, XUAN LAN T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,689

Applicant(s)

OKANAKA ET AL.

Examiner

Lan Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: drawings.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 229. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. It is unclear about the status of figures 9A, 9B, 9C, 10A, 10B, 11A, 11B, 11C, 11D, 12C, 12D, 12E and 12F. It appears from the specification that these figures should be prior art since they are similar to the stopper of figure 13, the stopper of JP9-166175 and the stopper of JP2001-349368. However, Applicant fails to specify that these figures are prior art or not. Furthermore, Applicant does not specify that these figures represent different embodiments of the instant invention. In fact, the specification only mentioned one embodiment of the instant invention in figures 1, 2, 3, 4, 5, 6, 7A, 7B, 8A, 8B, 8C, 9D, 12A and 12B. It is required that an explanation and/or

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amendments to the specification and the drawings be accompanied to the Response to this Office Action. Applicant amended figures 9A, 9B, 9C, 10A, 10B, 11A, 11B, 11C, 11D, 12C, 12D, 12E and 12F to include labels "Comparative Example 1", etc. in the Response dated 6/30/05. These labels do not specifically identify these figures as prior art or as different embodiments of the present invention. Hence, the objection is repeated above for figures 9A, 9B, 9C, 10A, 10B, 11A, 11B, 11C, 11D, 12C, 12D, 12E and 12F. The amended figures 9D, 12A and 12B including labels "Present Invention" have been approved.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next

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Office action. The objections to the drawings as stated above will not be held in abeyance.

Specification

3. The disclosure is objected to because:
 - Applicant amended the specification and claim 1 to include the at least one central projection and the pair of peripheral projections project outward from the first abutting plane of the base portion with a substantially same height. This is contradictory to the Abstract and through out the rest of specification wherein the different heights of the peripheral projections and central projections are emphasized. This amended feature is also deemed to be new matter since as originally filed the Abstract and the specification only emphasized the importance and benefits of the difference in heights between the peripheral projections and the central projections. The drawings and table 1 as originally filed were deemed to be in error and were objected to.
 - Table 1 is objected to because there are no explanations for symbols X, O and the triangle, in the specification.Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The amended feature of claim 1, "wherein the at least one central projection and the pair of peripheral projections project outward from the first abutting plane of the base portion with a substantially same height." is contradictory to what is deemed to be the essence of the invention as understood from the originally filed disclosure. The contradiction renders claims 1-8 non-enabled to one of ordinary skill in the art to make and/or use the invention.

6. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amended feature of claim 1, "wherein the at least one central projection and the pair of peripheral projections project outward from the first abutting plane of the base portion with a substantially same height." is deemed to be new matter since as originally filed the Abstract and the specification only emphasized the importance and benefits of the difference in heights between the peripheral projections and the central projections.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

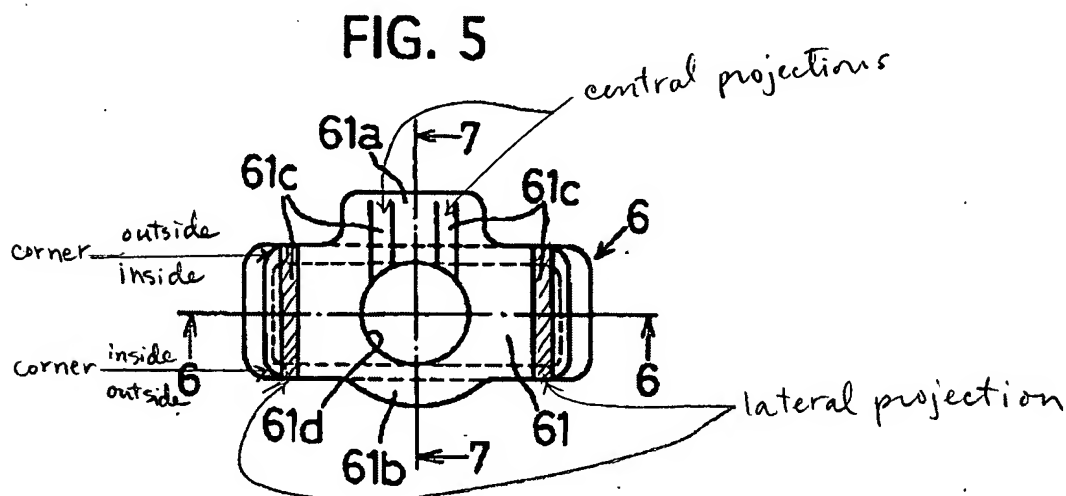
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanahashi et al. (EP 0780592 A2).

Re: claim 1, Tanahashi et al. show a stopper structure for an engine mount in figure 1 including an elastic body 3 elastically connecting two mounting members 2, 1, as in the present invention, the stopper structure comprising: a rigid abutting member 51 connected to one of the two mounting members, and extending in a longitudinal direction with a substantially rectangular shape in cross section as shown in figure 2, and a rubber stopper 6 including: a base portion 61 of tubular shape in cross section, and being secured press-fit onto the rigid abutting member without being adhesive to a superficial surface of the rigid abutting member, as mentioned in the Abstract, a pair of peripheral projections 61c, please see the marked up figure 5 below, formed on laterally opposite sides of a first abutting plane of the base portion and extending in the longitudinal direction of the rigid abutting member, and at least one central projection 61c, please see the marked up figure 5 below, formed on an intermediate area interposed between the pair of peripheral projections of the first abutting plane surface of the base portion, wherein the pair of peripheral projections are situated above laterally opposite corners of a corresponding first abutting plane of the rigid abutting

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member, respectively, and have a width dimension extending inside and outside the corners of the rigid abutting member, as marked in figure 5 below.



Re: claim 2, Tanahashi further shows the base portion 61 has a wall thickness dimension larger than the height dimension of the pair of peripheral projections in figure 6.

Re: claim 3, Tanahashi shows the base portion 61 in contact with bracket 4.

Re: claim 4, figure 6 of Tanahashi shows the stopper as claimed.

Re: claim 5, Tanahashi shows a plurality of central projections arranged in at least one straight line extending parallel to the pair of peripheral projections.

Re: claim 6, figure 5 of Tanahashi shows the arrangement of the central projections and the peripheral projections as claimed.

Re: claim 8, Tanahashi further shows the stopper to be for a hanging type engine mount, a connector arm 2 disposed below the engine mount and that the rubber stopper is brought into abutting contact with an abutting portion, bracket 4, provided on the body of the vehicle as claimed.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanahashi et al. (EP 0780592 A2) in view of Leibach.

Tanahashi's stopper structure, as rejected in claim 1, is shown to comprise rib shaped central projections while claim 7 requires the central projections to be conical risers. Leibach teaches in column 5, line 44 that the central projections can be a variety of shapes including ribs and conical risers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Tanahashi's stopper structure to include conical risers for central projections as taught by Leibach since Leibach taught the variety of shapes for central projections including ribs and conical risers to satisfy the different requirements of the shock absorbing characteristics of the stopper structure.

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered.

Applicant argues that Tanahashi's lateral projections do not comprise a width dimension extending inside and outside the corners of the rigid abutting member. The marked up figure 5 above clearly shows that Tanahashi's lateral projections meet the claimed feature of claim 1. Due to Applicant's amendment to claim 1, a new ground of rejection, based on Tanahashi for claims 1-6 and 8, and Tanahashi in view of Leibach for claim 7, is presented above.

Applicant's amendments to claim 1 and to the specification are deemed to introduce new matter as explained above. Furthermore, the amendments to claim 1 and the specification introduce confusion in that the Examiner is unclear of the essence of the present invention. As originally filed, the difference in heights between the lateral projections and the central projections has been emphasized for the importance and benefits that could be derived from the height difference. No importance or benefits have been mentioned for the same height between the lateral projections and the central projections. Furthermore, no discussion was provided for feature of same height between the lateral projections and the central projections. As mentioned above, the drawings and table 1 were deemed to be in error. From the many times that the importance and benefits of having the different heights have been emphasized in the original disclosure, the amended feature of the lateral projections and the central projections having the same height is deemed to be new matter.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on M-F, 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lan Nguyen
Primary Examiner
Art Unit 3683

Lan Nguyen
9/6/05



REPLACEMENT SHEET

FIG. 9D

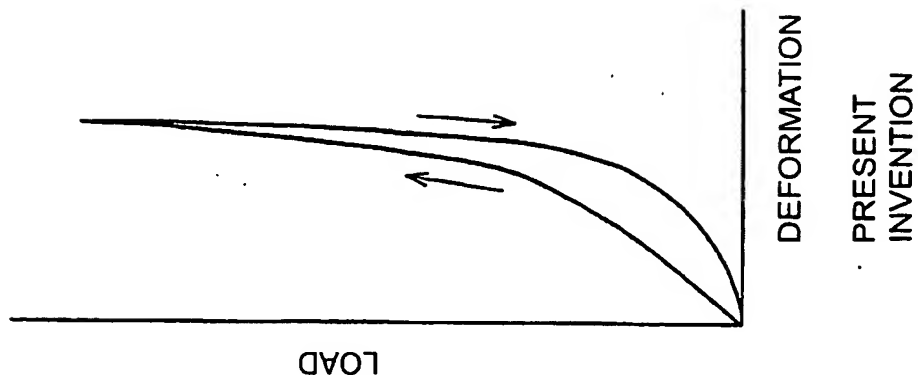


FIG. 9C

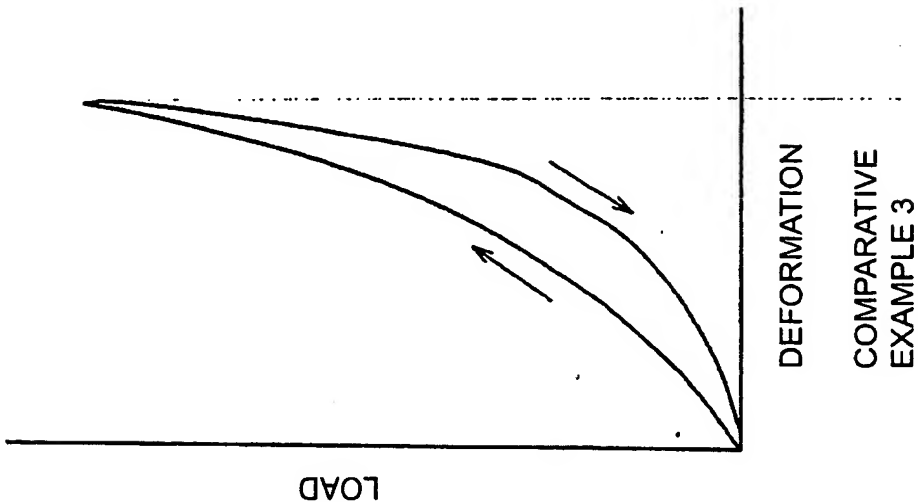


FIG. 9B

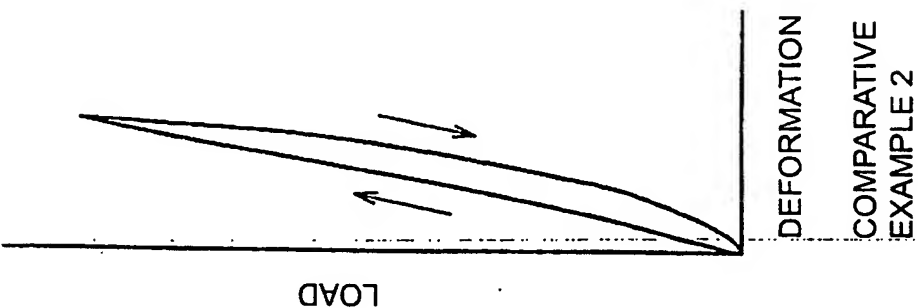
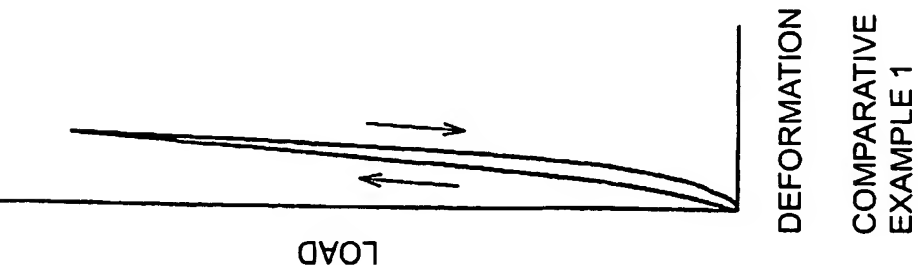


FIG. 9A



NOT approved
XLN
9/6/05

FIG. 10B

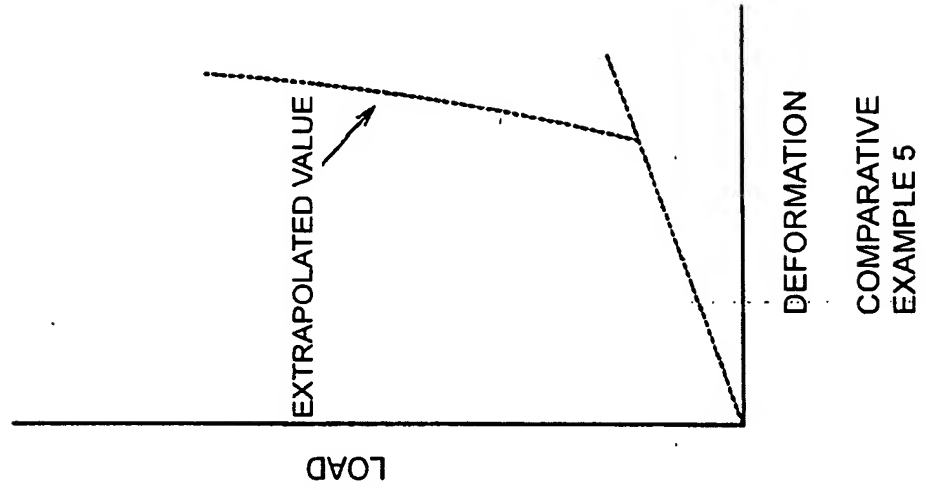
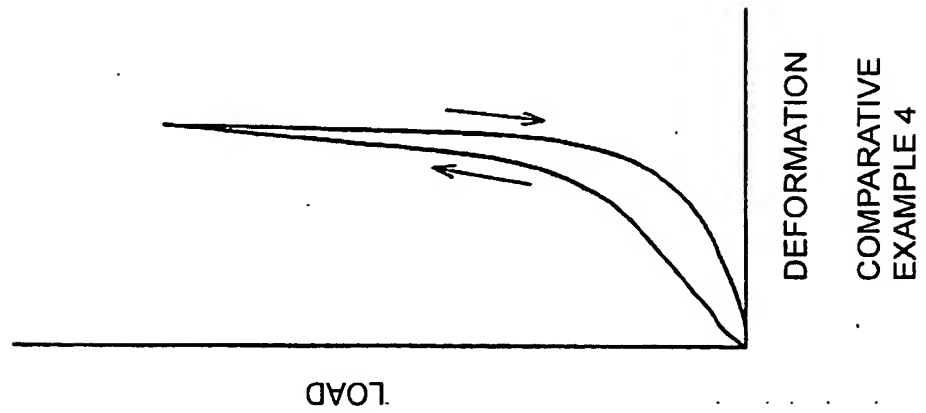
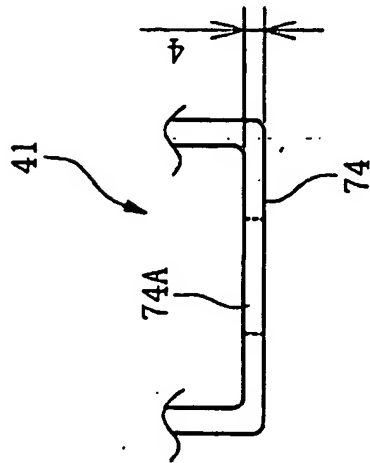


FIG. 10A



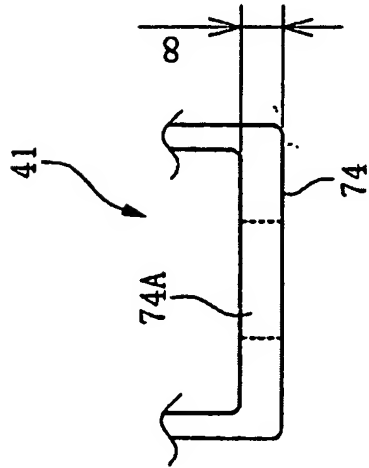
NOT approved
XLN
9/6/05

FIG. 11A



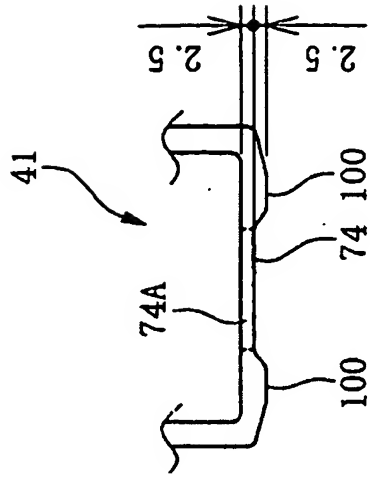
COMPARATIVE EXAMPLE 1

FIG. 11B



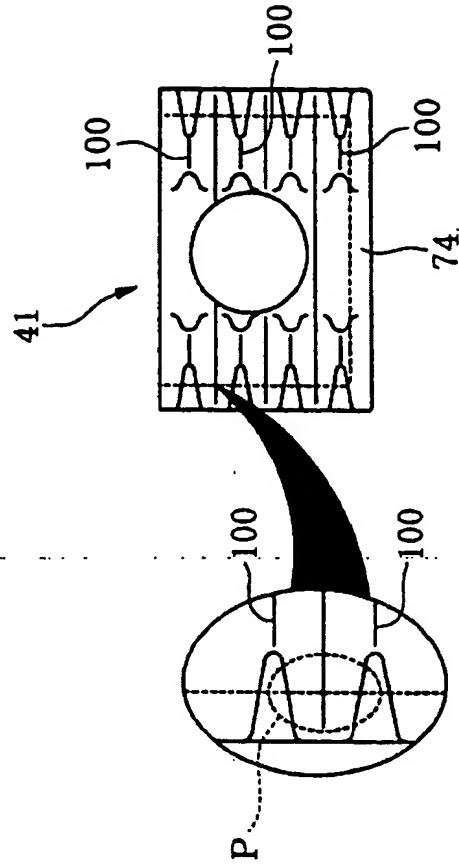
COMPARATIVE EXAMPLE 2

FIG. 11C



COMPARATIVE EXAMPLE 3

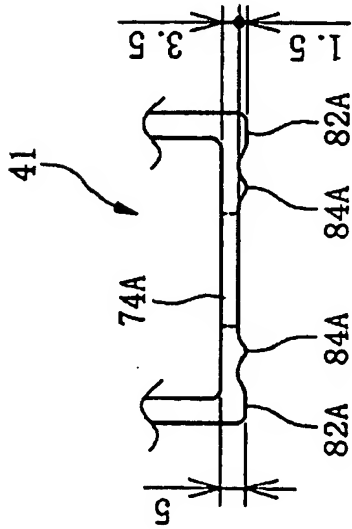
FIG. 11D



COMPARATIVE EXAMPLE 3

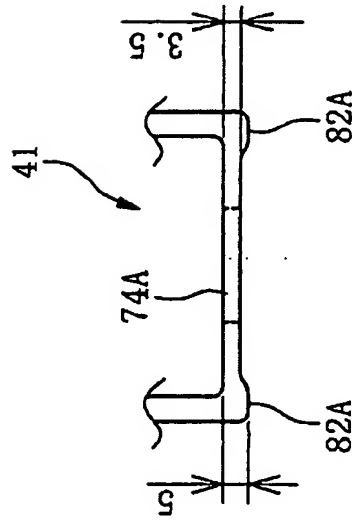
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FIG. 12A



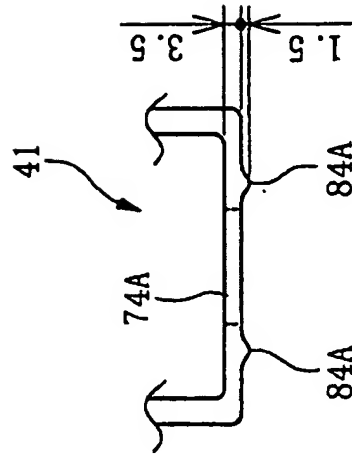
PRESENT INVENTION

FIG. 12C



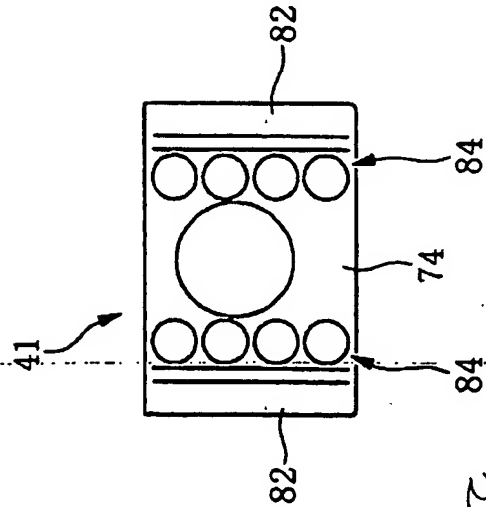
COMPARATIVE EXAMPLE 4

FIG. 12E



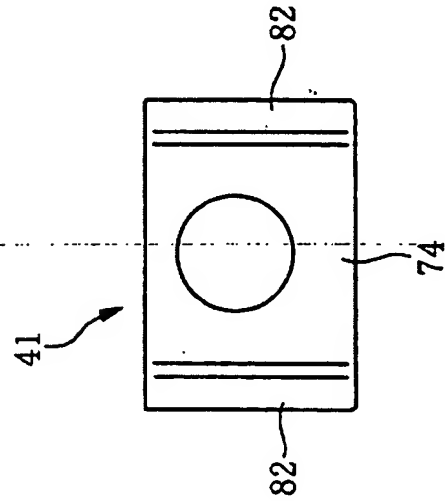
COMPARATIVE EXAMPLE 5

FIG. 12B



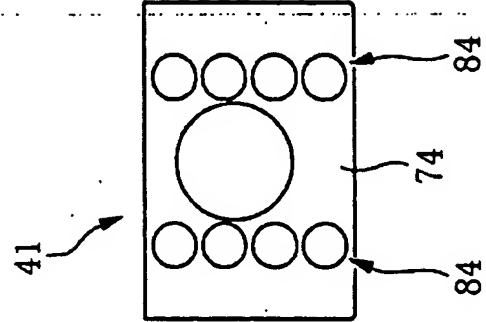
PRESENT INVENTION

FIG. 12D



COMPARATIVE EXAMPLE 4

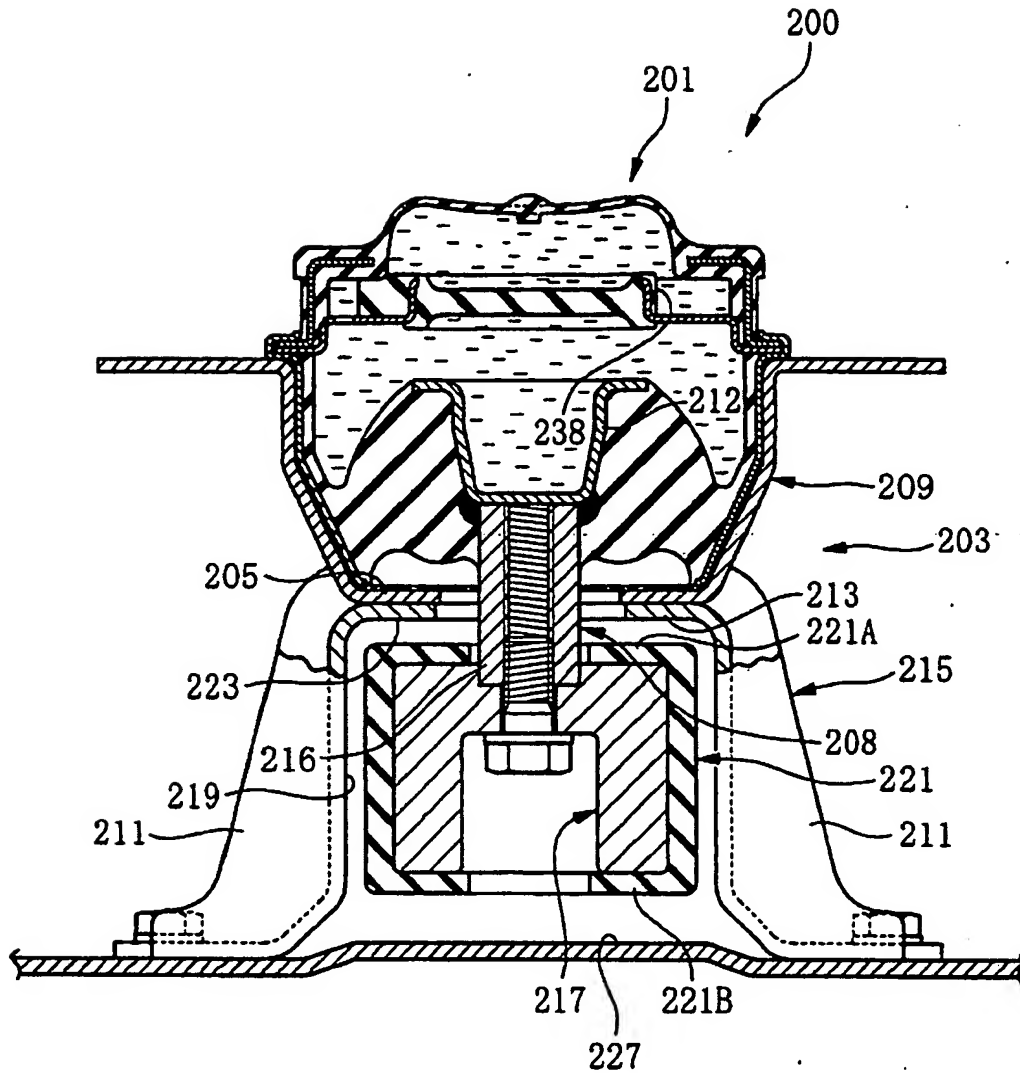
FIG. 12F



COMPARATIVE EXAMPLE 5

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FIG. 13



PRIOR ART

NOT approved
XW
9/6/05